

telephone interview on December 10, 2002, that the rejection over claims 1-2 and 7 under 102(e) was in error, and instead, claims 1-4 and 7 should have been indicated as rejected under 102(e), since each of these claims was addressed in the statement of the rejection on pages 2 and 3 of the Office action.

The Examiner, in referencing FIGS. 1a-1d, asserted that Root reads on the apparatus of independent claims 1 and 2 and the testing method of independent claim 7. Applicants respectfully traverse the rejection. Claim 1 has been canceled and therefore the rejection is moot. Moreover, independent claims 2 and 7, as amended, are patentably distinct over Root for the reasons set forth *infra*.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the method and device disclosed by Root that scotch the factual determination that Root identically describe the claimed inventions within the meaning of 35 U.S.C. § 102.

Root discloses at col. 1, lines 49-62, that each tile is moved independently in an X and Y direction with the control knobs 108 and 107. However, in contrast claim 2 describes in pertinent part, that all of said probe units being concurrently (i.e. all at a time) movable along the rails included in the first rail group and the second rail group. Similarly, claim 7 recites, in pertinent

part, that the plurality of probe units is concurrently adjusted. Applicants submit that Root is not capable of concurrently moving or adjusting a plurality of probing units along the rails, since as stated above, each tile is moved independently in a X and Y direction with the control knobs 108 and 107. Accordingly, Root fails to disclose every limitation of the present claims and therefore the rejection is not legally viable.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Root (U.S. Pat. No. 6,201,402) in view of Ohno et al. (U.S. Pat. No. 6,384,734). Applicants respectfully traverse.

In the statement of the rejection for claim 5, the Examiner acknowledged that Root is silent as to the displacement measuring means and the displacement measurement value feedback means of claim 5. The Examiner relied on the additional teachings of Ohno et al. to remedy the deficiencies of Root. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to modify the system of Root and provide the displacement measuring means and the displacement measurement value feedback means as allegedly taught by Ohno et al., in order to achieve good results from testing. Applicants respectfully traverse the rejection.

Applicants submit that Ohno et al. fail to remedy the above deficiencies of Root. Applicants submit that in view of the patentability of independent claim 2, as discussed above, dependent claim 5 is patentable in view of its dependency on claim 2. The Examiner is therefore requested to reconsider and withdraw the rejection over claim 5.

In light of the amendments and remarks above, the application should be considered in condition for allowance and the case passed to issue. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

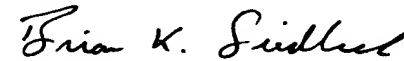
Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached appendix is entitled "Version with the Markings to Show the Changes Made".

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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## APPENDIX

Version with the Markings to Show the Changes MadeIN THE CLAIMS

Please cancel claim 1.

Please amend claims 2 and 7 as follows:

2. (Amended) A substrate testing apparatus comprising:
- a first rail group made of a plurality of rails disposed in parallel with each other;
  - a second rail group made of a plurality of rails disposed in parallel with each other in a direction that crosses said first rail group;
  - a plurality of probe units disposed to cover respective intersections of the rails included in said first rail group and the rails included in said second rail group, all of said probe units being concurrently movable [and being movable] along the rails included in said first rail group and said second rail group; and
  - corresponding interval maintaining means for keeping each rail included in said first rail group at an interval corresponding to an arrangement of locations to be measured on a substrate subjected to measurement,
  - wherein said plurality of probe units each comprise a probing needle to be brought into contact with a surface of said substrate.
7. (Amended) A substrate testing method using a plurality of probe units disposed to cover respective intersections of rails included in a first rail group made of a plurality of rails disposed in parallel with each other and rails included in a second rail group made of a plurality of rails disposed in parallel with each other in a direction that crosses said first rail group, said plurality of probe units being movable along the rails included in said first rail group and said second rail group and each comprising a probing needle to be brought into contact with a surface

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of a substrate subjected to measurement, wherein said probing needles are brought into contact with said substrate in a state in which an arrangement of said plurality of probe units is concurrently adjusted so that an interval between said probing needles corresponds to an arrangement of locations to be measured on said substrate.